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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,615	01/25/2001	Kashichi Hirota	P66355US0	5712
136	7590	12/16/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				PAN, YUWEN
ART UNIT		PAPER NUMBER		
		2682		

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/768,615	HIROTA ET AL.	
	Examiner Yuwen Pan	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 August 2004.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

***Response to Arguments***

1. Applicant's arguments filed 6/16/04 have been fully considered but they are not persuasive.

The applicant argues that Toyooka is distinguishable from the invention as recited in claim 1 in that in the present invention, the adhesive layer, the fine fragments, and the painted layer are all applied at the rear face of the body; whereas in Toyooka, the foil-decorating film 1 (which comprises the transparent base film 3, the symbol layer 6, the hiding layer 7, and the transparent adhesive layer 15) is applied to the front face of the body.

The examiner respectfully disagrees because the applicant narrowly interprets the teaching of Toyooka and broad its claim interpretation to favor his argument. Claim 1 renders limitations of a body formed of a plastic material, wherein at least part of said body includes a section formed of a transparent material; an adhesive layer provided on the rear face of said section formed of said transparent material. Literally, the adhesive layer provided on the rear face of part of the plastic material in which is transparent. The part of the plastic material in which is transparent could be referred to item 21, the transparent display window, from figure 1. Thus, the transparent adhesive layer (15) is provided on the rear face of the transparent display window. Furthermore, rear of something is just a relative term, one side of object could be the rear or the front depend on the view's perspective.

The applicant further argues that Toyooka doesn't teach the limitation of colored or lustrous *fine fragments dispersedly applied* onto adhesive layer so that the fragments are adhesively held on said adhesive layer. The examiner respectfully disagrees because again the applicant narrows the teaching of Toyooka. Toyooka teaches that symbol layer 6 may be formed by characters,

graphics, symbols or patterns, etc. It's not limited only to characters or symbols as company's name. It could be graphics, such as flowers, or balloons, which dispersedly applied on body of a phone covers.

With respect to the argument of claim 2, since the applicant is challenges the "Official Notion" in first office action, the examiner would support the finding with adequate evidence. See the following for detail office action.

#### **DETAILED ACTION**

##### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,3-7, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Toyooka (US006504928B1).

Per claims 1, 3, 4 and 9, 10, Toyooka discloses a portable telephone (see column 1 and line 8-15) comprising:

A body formed of a plastic material, wherein at least part of said body includes a section formed of a transparent material (see column 5 and lines 3-10, figure 1 and item 1, 3 and 21);

An adhesive layer provided on the rear face of said section formed of said transparent material (see figure 1 and item 15);

Colored or lustrous fine fragments dispersedly applied onto said adhesive layer so that the fragments are adhesively held on said adhesive layer (see figure 1 and 2, column 9 and lines 39-51); and

A painted layer provided on said adhesive layer said colored or lustrous fine fragments, said painted layer including a light-permeable ink in the form of fine fragments (see figure 1 and item 7 and column 5 and lines 40-67, see column 6 and line 42-67).

Per claims 5-7, Toyooka discloses a portable telephone (see column 1 and line 8-15) comprising:

A display having a display panel (see figure 1 and item 21);

A transparent guard plate disposed outside display panel with leaving a space to said display panel, wherein said transparent guard plate includes a transparent section corresponding to said display panel and a peripheral section around said transparent section, said peripheral section being formed of a transparent material (see column 9 and lines 34-38, figure 5 and items 8 and 21);

An adhesive layer provided on the rear face of said peripheral section (see figure 5 and item 17 and figure 1 and item 15);

Colored or lustrous fine fragments dispersedly applied onto said adhesive layer so that the fragments are adhesively held on adhesive layer (see figure 1 and 2, column 9 and lines 39-51);

A painted layer provided on said adhesive layer said colored or lustrous fine fragments, said painted layer including a light-permeable ink in the form of fine fragments (see figure 1 and item 7 and column 5 and lines 40-67, see column 6 and line 42-67).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyooka (US006504928B1) in view of Synder (US006389268B1) and further in view of Yoshida et al (US006421181B1).

Toyooka discloses a portable telephone (see column 1 and line 8-15) comprising:

A display having a display panel (see figure 1 and item 21);

A transparent guard plate disposed outside display panel with leaving a space to said display panel, wherein said transparent guard plate includes a transparent section corresponding to said display panel and a peripheral section around said transparent section, said peripheral section being formed of a transparent material (see column 9 and lines 34-38, figure 5 and items 8 and 21);

An adhesive layer provided on the rear face of said peripheral section (see figure 5 and item 17 and figure 1 and item 15);

Colored or lustrous fine fragments dispersedly applied onto said adhesive layer so that the fragments are adhesively held on adhesive layer (see figure 1 and 2, column 9 and lines 39-51);

A painted layer provided on said adhesive layer said colored or lustrous fine fragments, said painted layer including a light-permeable ink in the form of fine fragments (see figure 1 and item 7 and column 5 and lines 40-67, see column 6 and line 42-67).

Toyooka doesn't teach said transparent section including a front face and rear face facing said display panel, said front face being formed as a convex lens having a convex surface.

Snyder discloses said transparent section including a front face and rear face facing said display panel, said front face being formed as a convex lens having a convex surface (see figure 2, and column 2 and lines 6-12).

Combination of Toyooka and Snyder doesn't teach rear face being formed as Fresnel lens having a convex lens function.

Yoshida et al discloses that Fresnel lens having a convex lens function is incorporated (see column 2 and lines 32-52).

It would have been obvious to one ordinary skill in the art at the time the invention was made to utilize Fresnel lens with convex function such that the magnified images are displayed, at a position adjacent to the screen.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toyooka (US006504928B1) in view of Brotz (US006115006A).

With respect to claim 2, Toyooka discloses a telephone (figure 1) comprising:

A body formed of a plastic material, wherein at least part of said body includes a section formed of a transparent material (see column 5 and lines 3-10, figure 1 and item 1, 3 and 21);

Toyooka doesn't disclose a luminous material mixed in said section formed of said transparent material by a predetermined ratio.

Brotz teaches that a luminous material mixed in said section formed of said transparent material by a predetermined ratio (see column 2 and lines 34-41). It would have been obvious to one ordinary skill in the art at the time the invention was made to combine mixing a luminous material with said transparent material by a predetermined ratio to observe information under insufficient light environment.

*Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yuwen Pan whose telephone number is 703-305-7372. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yuwen Pan  
December 10, 2004

  
LEE NGUYEN  
PRIMARY EXAMINER